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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/754,541 | 01/12/2004 | Yasuharu Urano | 247564US0 | 9286 |
| 22850 | 7590 | 02/06/2006 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | BARKER, MICHAEL P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1626 | |
| DATE MAILED: 02/06/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------|--------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/754,541 | URANO ET AL. | |
| | Examiner | Art Unit | |
| | Michael P. Barker | 1626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 16,17,23,24,30,31,37 and 38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 is/are allowed.
- 6) ☒ Claim(s) 1,8,10,12-15,18,26-29,32-36 and 39 is/are rejected.
- 7) ☒ Claim(s) 2-6,9,11,19-22 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/12/04, 8/20/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-39 are pending in this application. Applicant has elected Group I, **Claims 1-15, 18-22, 25-29, 32-36, and 39**, and Group II, **Claims 16-17, 23-24, 30-31, and 37-38**, has been withdrawn from further consideration.

Claims 1, 8, 10, 12-15, 18, 26-29, 32-36, and 39 are rejected. **Claims 2-6, 9, 11, 19-22, and 25** are objected to. **Claim 7** is allowable.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. Australia 2003900116, filed on January 13, 2003 and parent Application No. Australia 2003905406, filed on October 6, 2003.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on April 12, 2004 and July 20, 2004 were correctly filed. The submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner. Please refer to Applicant's copy of the IDS (PTO-1449) submitted herewith.

Response to Arguments

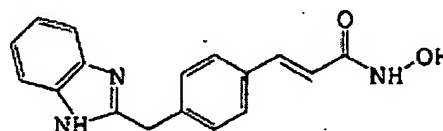
Applicant's election with traverse of Group I in the reply filed on December 29, 2005 is acknowledged. The traversal is on the ground(s) that searching the claims of both Groups I and II does not present a serious burden to the Office. In the instant case, the product as claimed can be used in a materially different process of using that product as demonstrated throughout the specification and in **Claims 16-17, 23-24, 30-31, and 37-38**, for example, which are specifically

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directed toward different methods of using the compounds of Formula I. Therefore, separate search considerations are involved, which would pose a burden if the Inventions were left unrestricted. Also, the fields of search are not coextensive. Besides performing a class/subclass search, the Examiner performs a commercial database search and an automated patent system (text) search.

Group II is distinct and independent from Group I because it is directed to a different statutory class of invention, such that the practice of Group II would not result in the practice of Group I. In addition, because of the numerous classes and subclasses in each of the Groups, a serious burden is imposed on the examiner to perform a complete search of the defined areas. Therefore, the requirement is still deemed proper and is therefore made FINAL.

Analysis of the Elected Group Invention



Applicant's provisional election of the compound, depicted in **Claim 7** on *p.* 233, is acknowledged. The elected species was found to be free of the prior art, thus the search was expanded to include the entirety of Group I. However, Group I was not found to be free of the prior art, giving rise to the rejections which follow.

Claim Rejections - 35 USC § 102(a)

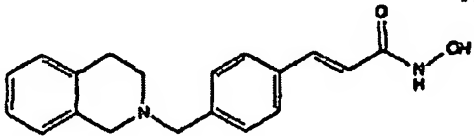
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 8, 10, 12-15, 18, 26-29, 32-36, and 39 are rejected under 35 U.S.C. 102(a) as being anticipated by WIPO Publication WO 02/22577, published March 21, 2002 [hereinafter "Bair, et al."]. Specifically, portions of Applicant's claimed genus, as described by Group I, are anticipated by certain exemplified embodiments described in Bair, et al. The following list is not

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exhaustive and does not include each and every species anticipating Applicant's broad genus as defined by **Claims 1, 8, and 10**.

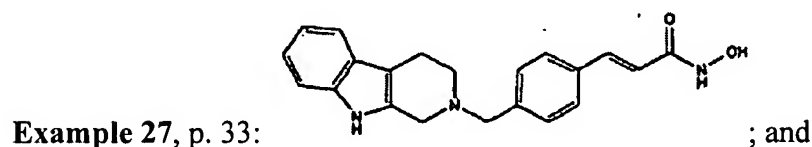
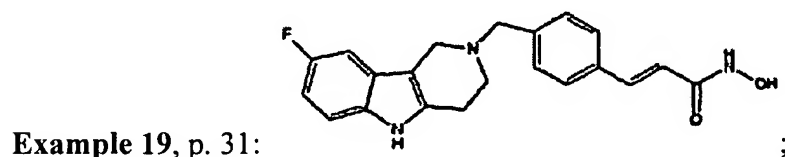
As a courtesy to Applicant, the first example lists the substituents used from Applicant's Group I which result in a species anticipated by a species exemplified by Bair, et al. Bair, et al.

teaches the following compound,  [Example 5, p. 29],

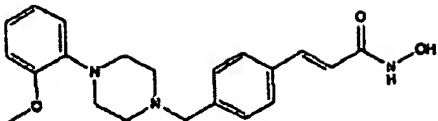
which anticipates Applicant's **Claims 1, 8, 10, 12-15, 18, 26-29, 32-36, and 39**, specifically wherein (reciting from Applicant's **Claim 1, Claim 8, and Claim 10**):

- R^1 is N-containing heterocyclic ring substituted with one or more suitable substituent(s);
- R^2 is hydroxyamino;
- R^3 is hydrogen;
- L^1 is $-(CH_2)_n-$; and
- L^2 is lower alkenylene

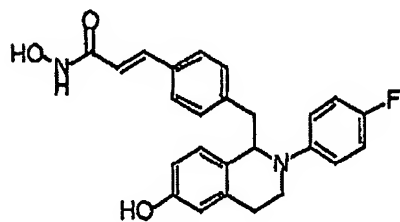
The subsequent examples do not explicitly typify the combination of substituents used to reach the specific species but can be created using Applicant's broad genus and thus form the basis of this 102(a) rejection. Bair, et al. teaches the following compounds, all of which anticipate Applicant's **Claims 1, 8, 10, 12-15, 18, 26-29, 32-36, and 39**:



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Example 170, p. 58: . Again, these examples of anticipating species do not provide an exhaustive list of each and every anticipating species contained within Bair, et al.

Claims 1, 8, 10, 12-15, 18, 26-29, 32-36, and 39 are rejected under 35 U.S.C. 102(a) as being anticipated by WIPO Publication WO 02/24653, published March 28, 2002 and given a priority date of March 17, 1999 [hereinafter “Bhagwat, et al.”]. Specifically, portions of Applicant’s claimed genus, as described by Group I, are anticipated by certain exemplified embodiments described in Bhagwat, et al. Bhagwat, et al. teaches the following compound,



[**Example 145**, p. 161], which anticipates Applicant’s **Claims 1, 8, 10, 12-15, 18, 26-29, 32-36, and 39**, specifically wherein (reciting from Applicant’s **Claim 1, Claim 8, and Claim 10**):

- **R¹** is N-containing heterocyclic ring substituted with one or more suitable substituent(s);
- **R²** is hydroxyamino;
- **R³** is hydrogen;
- **L¹** is $-(CH_2)_n-$; and
- **L²** is lower alkenylene.

Claim Rejections - 35 USC § 102(e)

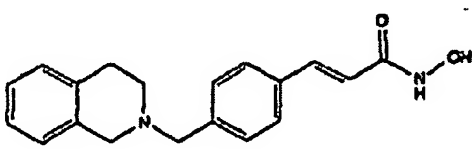
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8, 10, 12-15, 18, 26-29, 32-36, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by WIPO Publication WO 02/22577, published March 21, 2002 and given a priority date of September 1, 2000 [hereinafter “Bair, et al.”]. Specifically, portions of Applicant’s claimed genus, as described by Group I, are anticipated by certain exemplified embodiments described in Bair, et al. The following list is not exhaustive and does not include each and every species anticipating Applicant’s broad genus as defined by **Claims 1, 8, and 10**.

As a courtesy to Applicant, the first example lists the substituents used from Applicant’s Group I which result in a species anticipated by a species exemplified by Bair, et al. Bair, et al.

teaches the following compound,  [Example 5, p. 29], which anticipates Applicant’s **Claims 1, 8, 10, 12-15, 18, 26-29, 32-36, and 39**, specifically wherein (reciting from Applicant’s **Claim 1, Claim 8, and Claim 10**):

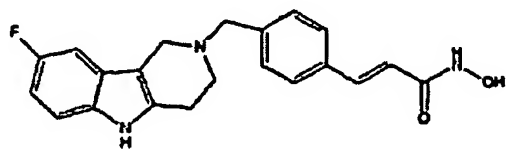
- **R¹** “is N-containing heterocyclic ring substituted with one or more suitable substituent(s)”;
- **R²** is hydroxyamino;
- **R³** is hydrogen;

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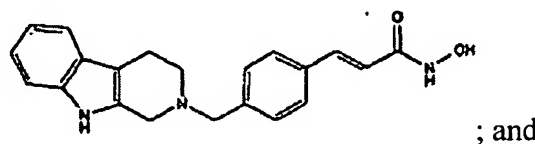
- L^1 is $-(CH_2)_n-$; and
- L^2 is lower alkenylene

The subsequent examples do not explicitly typify the combination of substituents used to reach the specific species but can be created using Applicant's broad genus and thus form the basis of this 102(e) rejection. Bair, et al. teaches the following compounds, all of which anticipate Applicant's **Claims 1, 8, 10, 12-15, 18, 26-29, 32-36, and 39**:

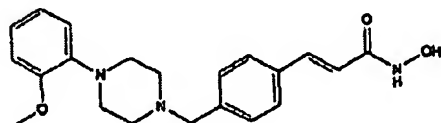
Example 19, p. 31:



Example 27, p. 33:



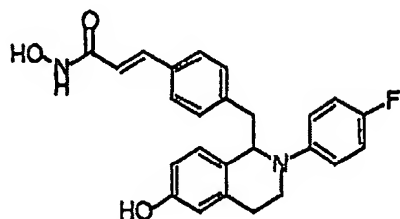
Example 170, p. 58:



. Again, these examples of anticipating species do not provide an exhaustive list of each and every anticipating species contained within Bair, et al.

Claims 1, 8, 10, 12-15, 18, 26-29, 32-36, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by WIPO Publication WO 02/24653, published March 28, 2002 and given a priority date of March 17, 1999 [hereinafter "Bhagwat, et al."]. Specifically, portions of Applicant's claimed genus, as described by Group I, are anticipated by certain exemplified embodiments described in Bhagwat, et al. Bhagwat, et al. teaches the following compound,

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[**Example 145**, p. 161], which anticipates Applicant's **Claims 1**,

8, 10, 12-15, 18, 26-29, 32-36, and **39**, specifically wherein (reciting from Applicant's **Claim 1**, **Claim 8**, and **Claim 10**):

- **R¹** is N-containing heterocyclic ring substituted with one or more suitable substituent(s);
- **R²** is hydroxyamino;
- **R³** is hydrogen;
- **L¹** is $-(CH_2)_n-$; and
- **L²** is lower alkenylene.

Claim Rejections - 35 USC § 112

Claims 1, 8, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In each of **Claims 1, 8, and 10**, it is unclear as to the definition of "N-containing heterocyclic ring". It is noted that while **Claims 1, 8, and 10** are silent as to what is meant by "N-containing heterocyclic ring", Applicant's Specification defines "N-containing heterocyclic ring" using the open-ended language "including" and subsequently recites a list of examples. Exemplary language is not considered a definition which specifically points out the metes and bounds of what Applicant considers his invention.

The aforementioned reasons can also be used to as the basis for rejecting "suitable substituents" and "suitable heteroatoms" as used in **Claims 1, 8, and 10**.

Objections

Claim 8 is objected to under 37 CFR 1.75 as being a substantial duplicate of **Claim 1**.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claims 2-6, 9, 11, 19-22, and 25 are objected to for being based on a rejected base claim.

Claims 16-17, 23-24, 30-31, and 37-38 are objected to as being drawn to nonelected subject matter.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Barker whose telephone number is (571) 272-4341. The examiner can normally be reached on Monday-Friday 8:00 AM- 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699. The unofficial fax phone for this group are (571) 273-8300.

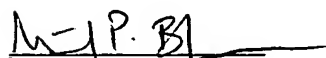
When filing a FAX in Technology Center 1600, please indicate the Header (upper right) "Official" for papers that are to be entered into the file, and " Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be

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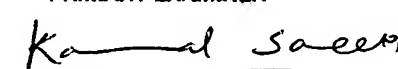
addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is viable through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael P. Barker
Patent Examiner, AU 1626

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER



(for) Joseph McKane
Supervisory Patent Examiner, AU 1626